

REMARKS/ARGUMENTS

1) Claim 18 stands rejected under 35 U.S.C. 102(e) as being anticipated by Jackson et al PN 4,727,500. Applicant respectfully traverses this rejection as set forth below:

In order that the rejection of Claim 18 be sustainable (under 35 U.S.C. 102(e)), it is fundamental that “each and every element as set forth in the claim be found, either expressly or inherently described, in a single prior art reference.” Verdegall Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also, Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), where the court states, “The identical invention must be shown in as complete detail as is contained in the ... claim”.

Furthermore, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claim 18, as amended, requires and positively recites, an apparatus, comprising: “means for sampling a temperature associated with the operation of said apparatus”, “means, responsive to said sampled temperature, for predicting **future temperature** associated with the operation of said apparatus” and “means for using said prediction for automatic temperature control within said apparatus”.

In contrast, Jackson discloses a technique in which temperature is sampled at the probe tip 13a at subsequent sample times and a final temperature is computed based upon the independent samplings. More specifically, Jackson discloses the following:

During the 25 second data collection period the circuit checks for a temperature drop every second, but stores temperature data only every 5 seconds. The stored temperature data for the starting time T0 and subsequent sample time T5, T10, T15, T20 and T25 is used **to compute a final probe temperature**,

corresponding to the patient's temperature (col. 3, lines 66 – col. 4, line 4).

After the elapse of 25 seconds, the final temperature TF is predicted and displayed through the use of one of the three prediction algorithms shown in FIGS. 4, 5 and 6. (col. 4, lines 5-8)

Thus, Jackson discloses use of multiple samples of temperature taken over time to predict the EXISTING temperature of a patient. Jackson does not teach or suggest a technique for “predicting” FUTURE temperature of a patient OR the probe of the apparatus inserted into a patient. As such, Jackson fails to teach or suggest, “means, responsive to said sampled temperature, for predicting **FUTURE temperature** associated with the operation of said apparatus”, as required by Claim 18.

Examiner in the Office Action of February 2, 2006, agrees that the electronic thermometer predicts the EXISTING temperature of a patient. Applicant respectfully submits that one having ordinary skill in the art at the time of the invention would not equate predicting “future temperature of the apparatus” with the Jackson’s “predicting EXISTING temperature of a patient”. Examiner’s determination is improper hindsight reconstruction. Accordingly, the Examiner’s rejection has not complied with case law such that, “each and every element as set forth in the claim be found, either expressly or inherently described, in a single prior art reference.” The 35 U.S.C. 102(e) rejection of Claim 18 over Jackson is erroneous and should be withdrawn.

2) Claims 17-18, 21, 74-79 and 122 stand rejected under 35 U.S.C. 102(e) as being anticipated by Dischler et al. PN 6,311,287. Applicant respectfully traverses this rejection as set forth below:

Applicant submitted on November 14, 2005, (received by USPTO November 17, 2005) his Declaration under 37 C.F.R. 1.131 to antedate the Dischler reference by showing conception of his invention on a date prior to October 11, 1994 and diligence in reducing his invention to practice

from a date prior to October 11, 1994, which is the first effective date of cited U.S. Patent to Dischler et al. (6,311,287), until the invention was actually reduced to practice on a date no later than December 15, 1994.

In an Office Action dated February 2, 2006, Examiner considered the Declaration filed on November 17, 2005, but determined it to be ineffective to overcome the Dischler et al. PN 6,311,287 reference for the stated reason that the Declaration does not indicate what claim limitations are supported by the cited Exhibits. Attached to this amendment, Applicant submits a Supplemental Declaration that indicates what claim limitations are supported by the claim limitations, as requested by Examiner. Accordingly, the evidence submitted is sufficient to establish a conception of the invention prior to the effective date of the Dischler et al reference. Accordingly, the rejection of claims 17-18, 21, 74-79 and 122 stand rejected under 35 U.S.C. 102(e) as being anticipated by Dischler et al. PN 6,311,287, is now moot.

3) Claims 19-20 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dischler et al PN 6,311,287 in view of Chen et al PN 5,422,806. Applicant respectfully traverses this rejection as set forth below:

Applicant submits herein his Supplemental Declaration under 37 C.F.R. 1.131 to antedate the Dischler reference by showing conception of his invention on a date prior to October 11, 1994 and diligence in reducing his invention to practice from a date prior to October 11, 1994, which is the first effective date of cited U.S. Patent to Dischler et al. (6,311,287), until the invention was actually reduced to practice on a date no later than December 15, 1994. Accordingly, the rejection of Claims 19-20 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dischler et al PN 6,311,287 in view of Chen et al PN 5,422,806, is now moot.

4) Claims 83-88 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dischler et al PN 6,311,287 in view of Kikinis PN 5,502,838. Applicant respectfully traverses this rejection as set forth below:

Applicant submits herein his Supplemental Declaration under 37 C.F.R. 1.131 to antedate the Dischler reference by showing conception of his invention on a date prior to October 11, 1994 and diligence in reducing his invention to practice from a date prior to October 11, 1994, which is the first effective date of cited U.S. Patent to Dischler et al. (6,311,287), until the invention was actually reduced to practice on a date no later than December 15, 1994. Accordingly, the rejection of Claims 83-88 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dischler et al PN 6,311,287 in view of Kikinis PN 5,502,838, is now moot.

5) Claims 88-91 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dischler et al. PN 6,311,287. Applicant respectfully traverses this rejection as set forth below:

Applicant submits herein his Supplemental Declaration under 37 C.F.R. 1.131 to antedate the Dischler reference by showing conception of his invention on a date prior to October 11, 1994 and diligence in reducing his invention to practice from a date prior to October 11, 1994, which is the first effective date of cited U.S. Patent to Dischler et al. (6,311,287), until the invention was actually reduced to practice on a date no later than December 15, 1994. Accordingly, the rejection of Claims 88-91 as being unpatentable over 35 U.S.C. 103(a), is now moot.

6) Claims 104-106 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dischler et al PN 6,311,287 in view of Hollowell, II et al PN 5,590,061. Applicant respectfully traverses this rejection as set forth below:

Applicant submits herein his Supplemental Declaration under 37 C.F.R. 1.131 to antedate the Dischler reference by showing conception of his invention on a date prior to October 11, 1994 and diligence in reducing his invention to practice from a date prior to October 11, 1994, which is the first effective date of cited U.S. Patent to Dischler et al. (6,311,287), until the invention was actually reduced to practice on a date no later than December 15, 1994. Accordingly, the rejection of Claims 104-106 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dischler et al PN 6,311,287 in view of Hollowell, II et al PN 5,590,061, is now moot.

7) Claims 110-112 and 117-118 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dischler et al PN 6,311,287 in view of Kikinis as applied to claims 83-88 above and further in view of Gephhardt et al PN 5,493,684. Applicant respectfully traverses this rejection as set forth below:

Applicant submits herein his Supplemental Declaration under 37 C.F.R. 1.131 to antedate the Dischler reference by showing conception of his invention on a date prior to October 11, 1994 and diligence in reducing his invention to practice from a date prior to October 11, 1994, which is the first effective date of cited U.S. Patent to Dischler et al. (6,311,287), until the invention was actually reduced to practice on a date no later than December 15, 1994. Accordingly, the rejection of Claims 110-112 and 117-118 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dischler et al PN 6,311,287 in view of Kikinis as applied to claims 83-88 above and further in view of Gephhardt et al PN 5,493,684, is now moot.

8) While Applicant disagrees with Examiner's interpretation of the Jackson reference for the reasons previously presented, if the rejection of Claim 18 over Jackson is the only rejection remaining after this amendment, Applicant is willing to allow Examiner to amend Claim 18 by Examiner's amendment, such that the term "the operation" is replaced with --power consumption--, if it will result in allowance of the application. If such an amendment is made,

Claim 18, as amended, would require and positively recite, an apparatus, comprising: “means for sampling a temperature **associated with power consumption of said apparatus**”, “means, responsive to said sampled temperature, for predicting **future temperature** associated with the operation of said apparatus” and “means for using said prediction for automatic temperature control within said apparatus”.

In contrast, Jackson discloses a technique in which temperature is sampled at the probe tip 13a at subsequent sample times and a final temperature is computed based upon the independent samplings. More specifically, Jackson discloses the following:

During the 25 second data collection period the circuit checks for a temperature drop every second, but stores temperature data only every 5 seconds. The stored temperature data for the starting time T0 and subsequent sample time T5, T10, T15, T20 and T25 is used to **compute a final probe temperature, corresponding to the patient's temperature** (col. 3, lines 66 – col. 4, line 4).

After the elapse of 25 seconds, the final temperature TF is predicted and displayed through the use of one of the three prediction algorithms shown in FIGS. 4, 5 and 6. (col. 4, lines 5-8)

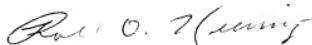
Thus, Jackson discloses use of multiple samples of temperature taken over time to predict the EXISTING temperature of a patient. Jackson does NOT teach or suggest, “means for sampling a temperature **associated with power consumption of said apparatus**”, as required by Claim 18, if amended. As such, Jackson does not teach or suggest that, “each and every element as set forth in claim 18, if amended, be found, either expressly or inherently described, in a single prior art reference”, as required by law. The 35 U.S.C. 102(e) rejection of Claim 18 would be overcome and should be withdrawn.

An amendment after a final rejection should be entered when it will place the case either in condition for allowance or in better form for appeal. 37 C.F.R. 1.116; MPEP 714.12. This amendment places the case in condition for allowance. At a minimum it places the case in better

form for appeal by further distinguishing Claim 18 over the Jackson reference AND by canceling Claims 114, 115, 120, 121, and 127-136.

Claims 17-21, 23, 74-113, 115-119 and 122-126 stand allowable over the cited art. Applicant respectfully requests allowance of the application as the earliest possible date.

Respectfully submitted,



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